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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,200	07/11/2001	Christopher S. Chen	56252	1223

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09/03/2002

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EXAMINER

NAFF, DAVID M

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 09/03/2002

fd

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

04/904200

Applicant(s)

Chen

Examiner

Haff

Group Art Unit

1651

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/11/01.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-4, 9, 10, 13, 27-19, 22, 24, 25, 27, 32, 33, 37, 38, 41, 42, 46 & 47 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-4, 9, 10, 13, 17, 19, 22, 24, 25, 27, 32, 33, 37, 38, 41, 42, 46 & 47 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

The preliminary amendment of 3/11/02 has been entered. The amendment canceled claims 7, 8, 11, 12, 14-16, 20-23, 26, 28-31, 34-36, 39, 40, 43-45 and 48-63, and amended claims 3-6, 9, 10, 13, 17-19, 22, 24 and 27.

5 It should be noted that claim 22 has been both canceled and amended. Clarification is required. Until applicants indicate whether the claim is to be canceled or amended, the claim will be presumed to be amended instead of canceled.

 Claims in the application are 1-6, 9, 10, 13, 17-19, 22, 24, 25, 27,
10 32, 33, 37, 38, 41, 42, 46 and 47.

 Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, 9, 10, 13, 17-19, 22, 24, 25 and 27, drawn to a method of adhering a biomolecule to a substrate by treating the
15 substrate with 1) a surfactant and 2) a biomolecule, classified in class 435, subclass 174.

II. Claims 32 and 33, drawn to a method of adhering a biomolecule to a substrate having steps of involving transferring a binding agent from a template to the substrate, adhering a non-adhesive
20 agent to substrate area not containing the binding agent and adhering biomolecules to the binding agent and not the non-adhesive agent, classified in class 435, subclass 180.

III. Claims 37 and 38, drawn to a method of adhering a biomolecule to a substrate involving steps of transferring a surfactant
25 from a template to the substrate, providing a binding agent to

the substrate that adheres to substrate area not containing the surfactant, providing a non-adhesive agent to the substrate having the pattern of hydrophilic and hydrophobic agents, providing a binding agent that binds to the hydrophilic agent, and adhering biomolecules to the binding agent and not the non-adhesive agent, classified in class 435, subclass 181.

IV. Claims 41 and 42, drawn to a method of patterning a surface by steps involving providing a mask to the surface wherein the mask has a pattern of open and closed areas, providing a non-adhesive agent to the surface, providing a binding agent, and adhering biomolecules to the binding agent and not the non-adhesive agent, classified in class 435, subclass 177.

V. Claims 46 and 47, drawn to a device for adhering a biomolecule in a predetermined position wherein the device has a substrate containing plurality of cytophilic regions that adhere a biomolecule and cytophobic regions to which biomolecules do not adhere contiguous with the cytophilic regions, and the cytophobic regions comprising a surfactant compound, classified in class 435, subclass 283.1.

The inventions are distinct, each from the other because:

The inventions of Groups I, II, III, IV and V can each be carried out without performing the invention of any other group to provide a different end result from any other group. The method Group I can be performed without carrying out the different steps of the methods of Groups II, III and IV, and without producing and using the device of

Group V. The method of group II can be performed without carrying out the different steps of the methods of Groups I, III and IV, and without producing and using the apparatus of Group V. The method of III can be performed without carrying out the different steps of the methods of
5 Groups I, II and IV, and without producing and using the device of Group V. The method of Group IV can be performed without carrying out the different steps of the methods of Groups I, II and III, and without producing and using the device of Group V. The device of Group V can be produced and used without carrying out steps required in methods I, II,
10 III and IV.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

15 Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance
20 with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications
25 from the examiner should be directed to David M. Naff whose telephone

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number is (703) 308-0520. The examiner can normally be reached on Monday-Thursday and every other Friday from about 8:30 AM to about 6:00 PM.

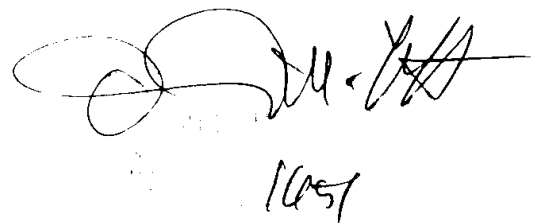
If attempts to reach the examiner by telephone are unsuccessful, a
5 message can be left on voice mail.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached at telephone number (703) 308-4743.

The fax phone number is (703) 872-9306 before final rejection or
10 (703) 872-9307 after final rejection.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

15

A handwritten signature, possibly reading "D. M. Wityshyn", is written in dark ink. Below the signature, the date "10/5/02" is handwritten.

DMN
8/30/02